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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,577

09/22/2005

Sylvie Pridmore-Merten

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EXAMINER

CLARK, AMY LYNN

ART UNIT

PAPER NUMBER

1655

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

01/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/526,577

Applicant(s)

PRIDMORE-MERTEN ET AL.

Examiner

Amy L. Clark

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1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-8, drawn to an orally administrable composition for improving hair or coat quality in humans or animals, which comprises as an active ingredient an effective amount of a molecule that stimulates energy metabolism of the cell or an antioxidant or combinatory admixtures thereof, in an orally acceptable carrier.

Group II, claims 9 and 12, drawn to the use of a molecule that stimulates energy metabolism of the cell, an antioxidant or a combination thereof, for the preparation of an orally administrable composition intended to improve hair or coat quality in humans or animals.

Group III, claims 10 and 12, drawn to the use of a molecule that stimulates energy metabolism of the cell or an antioxidant or a combination thereof, for the preparation of an orally administrable composition intended to stimulate hair growth in humans or animals.

Group IV, claims 11 and 12, drawn to a use of a molecule that stimulates energy metabolism of the cell or an antioxidant or a combination thereof, for the preparation of an orally administrable composition intended to modulate hair sebum lipid production and/or composition.

Group V, claims 13 and 16, drawn to a method to improve hair or coat quality of humans or animals, comprising administering to the individual a composition according to one of claims 1 to 7.

Group VI, claims 14 and 16, drawn to a method to stimulate hair growth in humans or animals, comprising administering to the individual a composition according to one of claims 1 to 7.

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Group VII, claims 15 and 16, drawn to a method to modulate hair sebum production and/or composition, comprising administering to the individual a composition according to one of claims 1 to 7.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 1, at least, is anticipated by or obvious over Cavazza (N, JP 09-176004 A, Translation Provided Herein). Cavazza teaches an oral medicinal composition comprising L-carnitine as an active component and an excipient (See Abstract and claims 1, 8 and 9). Cavazza further teaches administering the composition to an animal (See page 2 of the specification, paragraph 0023, continued through 4, paragraph 0037).

It is noted that the reference does not teach that the composition can be used in the manner instantly claimed, however, the intended use of the claimed composition does not patentably distinguish the composition, *per se*, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See also MPEP § 2112.01 with regard to inherency and product-by-process claims.

Consequently, the special technical feature which links the claims does not provide a contribution over the prior art, so unity of the invention is lacking.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows (elect from (i), (ii), (iii) and (iv). Please also further elect within (i) and (ii) as directed, as well in order to be compliant):

Group I:

Specie A:

(i) Elect either hair or coat, and further elect either human or animal from Claim 1.

-If human is elected, further elect either human food or dietary supplement from claim 5.

-If animal is elected, further elect either pet food or dietary supplement from claim 4.

(ii) Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 1.

-If a molecule or admixture is elected, further elect one molecule from Claim 2.

-If an antioxidant or admixture is elected, further elect one source of thiol (See lines 1-3) or a compound that upregulates their biosynthesis *in vivo* (See lines 3 and 4) or one antioxidant (See lines 4-7) or one compound or natural source (See lines 7-10) from claim 3.

(iii) Elect either stimulates hair growth from Claim 6 or modulates hair sebum lipid production and composition or composition from claim 7.

(iv) Elect either carnitine or an antioxidant or combinatory admixture from Claim 8.

Group II:

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Specie A:

(i). Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 9.

(ii) Elect either hair **or** coat, **and** further elect either humans **or** animals from Claim 9.

Group III:

Specie A:

(i). Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 10.

(ii) Elect either hair **or** coat, **and** further elect either humans **or** animals from Claim 10.

Group VI:

Specie A:

(i). Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 11.

(ii). Elect either hair **or** coat, **and** further elect either humans **or** animals from Claim 11.

Group V:

Specie A:

(i) Elect either hair **or** coat, **and** further elect either human **or** animal from Claim 1 and 13.

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-If human is elected, further elect either human food or dietary supplement from claim 5.

-If animal is elected, further elect either pet food or dietary supplement from claim 4.

(ii) Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 1.

-If a molecule or admixture is elected, further elect one molecule from Claim 2.

-If an antioxidant or admixture is elected, further elect one source of thiol (See lines 1-3) **or** a compound that upregulates their biosynthesis *in vivo* (See lines 3 and 4) **or** one antioxidant (See lines 4-7) **or** one compound **or** natural source (See lines 7-10) from claim 3.

(iii) Elect either stimulates hair growth from Claim 6 or modulates hair sebum lipid production and composition or composition from claim 7.

Group VI:

Specie A:

(i) Elect either hair **or** coat, **and** further elect either human **or** animal from Claim 1 and 14.

-If human is elected, further elect either human food or dietary supplement from claim 5.

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-If animal is elected, further elect either pet food or dietary supplement from claim 4.

(ii) Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 1.

-If a molecule or admixture is elected, further elect one molecule from Claim 2.

-If an antioxidant or admixture is elected, further elect one source of thiol (See lines 1-3) **or** a compound that upregulates their biosynthesis *in vivo* (See lines 3 and 4) **or** one antioxidant (See lines 4-7) **or** one compound **or** natural source (See lines 7-10) from claim 3.

(iii) Elect either stimulates hair growth from Claim 6 or modulates hair sebum lipid production and composition or composition from claim 7.

Group VII:

Specie A:

(i) Elect either hair **or** coat, **and** further elect either human **or** animal from Claim 1 and 15.

-If human is elected, further elect either human food or dietary supplement from claim 5.

-If animal is elected, further elect either pet food or dietary supplement from claim 4.

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(ii) Elect either molecule that stimulates energy metabolism or antioxidant or combinatory admixture thereof from Claim 1.

-If a molecule or admixture is elected, further elect one molecule from Claim 2.

-If an antioxidant or admixture is elected, further elect one source of thiol (See lines 1-3) or a compound that upregulates their biosynthesis *in vivo* (See lines 3 and 4) or one antioxidant (See lines 4-7) or one compound or natural source (See lines 7-10) from claim 3.

(iii) Elect either stimulates hair growth from Claim 6 or modulates hair sebum lipid production and composition or composition from claim 7.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Group I:

Specie A:

- (i) If human is elected, claims 1-3 and 5-8. If animal is elected, claims 1-4 and 6-8.
- (ii) If a molecule is elected, claims 1, 2, 4-8. If an antioxidant is elected, claims 1 and 3-8. If an admixture is elected, claims 1-8.
- (iii) claims 6 and 8.
- (iv) claims 7 and 8.

Group II:

Specie A: claims 9 and 12.

Group III:

Specie A: claims 10 and 12.

Group IV:

Specie A: claims 11 and 12.

Group V:

Specie A:

- (i) If human is elected, claims 1-3, 5-8, 13 and 16. If animal is elected, claims 1-4, 6-8, 13 and 16.
- (ii) If a molecule is elected, claims 1, 2, 4-8. If an antioxidant is elected, claims 1 and 3-8. If an admixture is elected, claims 1-8.
- (iii) claim 6.
- (iv) claim 7.

Group VI:

Specie A:

- (i) If human is elected, claims 1-3, 5-8, 14 and 16. If animal is elected, claims 1-4, 6-8, 13 and 16.
- (ii) If a molecule is elected, claims 1, 2, 4-8. If an antioxidant is elected, claims 1 and 3-8. If an admixture is elected, claims 1-8.
- (iii) claim 6.
- (iv) claim 7.

Group VI:

Specie A:

- (i) If human is elected, claims 1-3, 5-8, 15 and 16. If animal is elected, claims 1-4, 6-8, 13 and 16.
- (ii) If a molecule is elected, claims 1, 2, 4-8. If an antioxidant is elected, claims 1 and 3-8. If an admixture is elected, claims 1-8.

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(iii) claim 6.

(iv) claim 7.

The following claims are generic: Claims 1, 9, 10, 11, 13, 14 and 15.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

There is no common structural element (i.e., common broad chemical formula) shared by all the alternatives.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Amy L. Clark
January 8, 2007

Michele C. Flood
MICHELE FLOOD
PRIMARY EXAMINER